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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,207	04/09/2001	Masakazu Yoshimura	YOSHIMURA 11	3771

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EXAMINER

DEL SOLE, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,207

Applicant(s)

YOSHIMURA ET AL.

Examiner

Joseph S. Del Sole

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 6/29/00. It is noted, however, that applicant has not filed a certified copy of the 2000-201426 application as required by 35 U.S.C. 119(b).

Claim Objections

2. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 merely limits the material shaped, but fails to limit the claimed apparatus. An apparatus claim can only be further limited by limiting the structure of the apparatus, not by limiting the intended use.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodridge et al (5,714,179).

Goodridge et al teach a thermal pressure die having an uneven die surface (Fig 3, #92) to be brought into pressing contact with the material to be molded, wherein a

protection means (Fig 3, #90) of elastic and heat insulation property is provided on the uneven die surface (col 8, lines 41-59); the protection means is a protection element in sheet form, which is fixedly attached on the uneven die surface (Fig 3 and col 8, lines 41-59); a projection is formed on the uneven die surface to surround a part of the uneven die surface, the projection is adapted to form a decorative groove, and the protection means is provided on the part of the uneven die surface surrounded by the projection (Fig 3); a lower die and an upper die movable vertically to and from the lower die, wherein the uneven die surface with the protection means is provided thereon is defined in the upper die, while the lower die has an uneven die surface to mate with the uneven die surface.

Regarding the use of a trim cover and/or a foam cushion in the molding die, such limitations amount to process limitations which carry no weight in apparatus claims because they fail to further limit the structure of the apparatus. The trim cover and foam cushion, as claimed, are merely placed in the die and are not structurally related to the operation of the die.

5. Claims 1-3, 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Meloche (1,492,694).

Meloche teaches a thermal pressure die having an uneven die surface (Fig II, A) to be brought into pressing contact with the material to be molded, wherein a protection means (Fig II, B) of elastic and heat insulation property is provided on the uneven die surface (page 1, col 1, lines 40-46); the protection means is a protection element in sheet form, which is fixedly attached on the uneven die surface (Fig II and page 1, col 1,

lines 40-46); a projection is formed on the uneven die surface to surround a part of the uneven die surface, the protection means is provided on the part of the uneven die surface surrounded by the projection (Fig II); a lower die and an upper die movable vertically to and from the lower die, wherein the uneven die surface with the protection means is provided thereon is defined in the upper die, while the lower die has an uneven die surface to mate with the uneven die surface.

Regarding the use of a trim cover and/or a foam cushion in the molding die, such limitations amount to process limitations which carry no weight in apparatus claims because they fail to further limit the structure of the apparatus. The trim cover and foam cushion, as claimed, are merely placed in the die and are not structurally related to the operation of the die.

6. Claims 1-3, 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rounds (H1654).

Rounds teaches a thermal pressure die having an uneven die surface (Fig 4, #19) to be brought into pressing contact with the material to be molded, wherein a protection means (Fig 4, #19) of elastic and heat insulation property is provided on the uneven die surface (col 2 lines 18-26); the protection means is a protection element in sheet form, which is fixedly attached on the uneven die surface (Fig 4 and col 2, lines 18-26); a projection is formed on the uneven die surface to surround a part of the uneven die surface, the protection means is provided on the part of the uneven die surface surrounded by the projection (Fig 3); a lower die and an upper die movable vertically to and from the lower die, wherein the uneven die surface with the protection

Art Unit: 1722

means is provided thereon is defined in the upper die, while the lower die has an uneven die surface to mate with the uneven die surface.

Regarding the use of a trim cover and/or a foam cushion in the molding die, such limitations amount to process limitations which carry no weight in apparatus claims because they fail to further limit the structure of the apparatus. The trim cover and foam cushion, as claimed, are merely placed in the die and are not structurally related to the operation of the die.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodridge et al (5,714,179) in view of Turner (6,083,447).

Goodridge et al teach the apparatus as discussed above, including teaching an elastic protection sheet with a heat insulation property, the sheet being about 2mm thick (col 9, lines 42-50).

Goodridge et al fail to teach the protection element being formed from urethane foam.

Turner teaches the use of urethane foam as a mold material for the purpose of being sufficiently rigid to withstand pressures and being easily and inexpensively modified (col 4, lines 41-64).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the invention of Goodridge et al by using urethane foam as the material of the mold's protection element as taught by Turner because urethane foam withstands pressures and can be easily and inexpensively modified.

11. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meloche (1,492,694) in view of Turner (6,083,447).

Art Unit: 1722

Meloche teaches the apparatus as discussed above, including teaching a protection sheet with a heat insulation property, the sheet being about 2mm thick (page 1, col 1, lines 47-48).

Meloche fails to teach the protection element being formed from urethane foam.

Turner teaches the use of urethane foam as a mold material for the purpose of being sufficiently rigid to withstand pressures and being easily and inexpensively modified (col 4, lines 41-64).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the invention of Meloche by using urethane foam as the material of the mold's protection element as taught by Turner because urethane foam withstands pressures and can be easily and inexpensively modified.

References of Interest

12. Bracesco (4,979,890), Sakamoto et al (5,743,996) and Urai et al (4,929,304) are cited of interest to show the state of the art.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Del Sole whose telephone number is (703) 308-6295. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for non-after finals and (703) 872-9311 for after finals.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Joseph S Del Sole

J.S.D.
May 4, 2003

[Signature]
ROBERT DAVIS
PRIMARY EXAMINER
GROUP 4300 1722
5/5/03